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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,545	03/14/2001	Yuu Suzuki	05905.0133	5622

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Finnegan Henderson Farabow Garrett & Dunner  
1300 I Street NW  
Washington, DC 20005-3315

EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 04/14/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/700,545

Applicant(s)

SUZUKI ET AL.

Examiner

C. Marks

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 06 February 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Drawings***

The objection to the drawings has been withdrawn due to the amendment filed on 06 February 2003 correcting the reference character error.

### ***Claim Objections***

The objection to claims 6-8 for being in improper form for a multiple dependent claim has been withdrawn due to the amendment filed on 06 February 2003.

### ***Information Disclosure Statement***

The references crossed out have not been considered because there is no statement of relevance and no English language version of a search report can be located in the file. The only copy of the search report is presented in Japanese.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

Art Unit: 3713

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1 and those dependent therefrom, it does not appear to be disclosed in the specification that the special action to which the user is given prompts was never before operable during the game. It also does not appear to be disclosed in the specification that the special action will become operable for the first time in the game. Further, regarding claim 6, it does not appear to be disclosed that the each key action is shown by the actions of a displayed object.

Regarding claims 15 and those dependent therefrom, it does not appear to be disclosed in the specification that the special action to which the user is given prompts was never before operable during the game. It also does not appear to be disclosed in the specification that the special action will become operable for the first time in the game. Further, regarding claim 16, it does not appear to be disclosed that the each key action is shown by the actions of a displayed object.

Applicant is invited to point out support for all of the instances of new matter alleged above if the support exists within the specification.

Claims 7, 8, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7, 8, 17 and 18 do not distinctly define the scope of the claim to which it could be ascertained by one of ordinary skill in the art. The claims do not serve notice for a potential patent as to what would constitute infringement.

For examination purposes, that claims will be evaluated as best understood by the Examiner.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 7, 8, 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoshima et al (US Patent No. 6,241,524).

Aoshima et al. disclose an image processing apparatus and method which includes prompt processing means for outputting a prompt (Abstract) which indirectly teaches a key

Art Unit: 3713

operation corresponding to a special action of the game (FIG 10 and FIG 12). The prompt relates to an action other than the special action (FIG 10 and FIG 12) and suggests the key operation to the player.

Though Aoshima et al. do not explicitly state that the special action of the game for which the advice is being presented was never before operable; such functionality would be axiomatic to the system. Aoshima et al. state that the device computers and outputs advice data depending on the state of the game (Abstract) in order to allow the player to master the contents and operational process (Column 1, lines 62-64). Thus, any unfamiliar player can go on in the game, while seeing the advice relating to the game on the screen (Column 2, lines 3-7). Further, a game state judging section is used to select the advice appropriate (Column 2, lines 39-41) to output advice relating to what manner the player must take against the game (Column 2, lines 44-45). Aoshima et al. also limit the advice so once it has been displayed; it will not be displayed repeatedly and excessively (Column 3, lines 20-25).

Therefore, Aoshima et al. axiomatically give advice to the player for each special action in the game for which the player has not yet seen and henceforth has not been operable to the player. Upon receiving the advice, the player can then perform the special action for the first time (Column 3, lines 20-25). Furthermore, regarding claims 7, 8, 17, and 18, the image processing apparatus is inherently an electronic game apparatus and the storage medium inherently has a program stored upon it for executing the image processing means.

Claims 2-6, 9-14, 16, and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoshima et al. (US Patent No. 6,241,524) in view of Yamada (US Patent No. 6,149,523).

Aoshima et al. disclose an image processing apparatus that will provide messages to players based upon the actions of the player to suggest key operation. However, Aoshima et al. lack instructing the player on if the keys they hit were the correct keys associated with the special action. Further, Aoshima et al. lack a specific disclosure of how key sequences are handled.

Yamada et al. teach of instructing a player on mastering a complicated operating sequence for a game controller operation by providing feedback. Yamada et al. teach of instructing a player in the complicated operating sequence of a game controller by recognizing and displaying the input sequence by which the operating buttons are pressed and determining if the sequence matches a standard and correct sequence that is specified (Abstract, lines 3-9). The system determines whether or not the sequence matches the actions of a displayed object (Abstract, FIG 1C). The determining means can determine that no match has been made and at this point, corrective advice includes displaying the displayed object highlighted up to the point where the sequence no longer matched (Column 7, lines 34-36). These symbols are for a plurality of keys and are displayed on the screen and are according to the results of the determining means (Column 7, lines 33-35 and FIG 1B).

Yamada et al. also incorporate that when a series of operations is necessary for the key operations; each of those key operations is output in a prompt on the screen (FIG 1B) and shown by the actions of a displayed image (Column 5, lines 27-37). The key operations are output as a

Art Unit: 3713

result of the determining means. The keys that were correct in the determining means will be highlighted, while the keys that were incorrect, will not be highlighted (FIG 1B). The object displayed includes the key sequence output in the prompt and the action shows the button to be pressed (Column 5, lines 27-37). In this manner, each of the key operations is shown in the key prompt as well as the actions to be performed are displayed in the object by means of color to highlight the correct symbol, show the proper directions, and the time delays required (Column 5, lines 13-25). Thus, the actions of the displayed object represent the key operations to be hit by the player.

Upon completion, this repeat prompt of the identification symbols are then used to inform the player whether input operations match or do not match based upon the determination (Column 5, lines 50-60). Yamada et al. display these symbols in the same window as the gaming story is displayed. However it would have been obvious to one skilled in the art at the time of invention to incorporate these symbols into their own sub-screen as shown by Miyamoto et al. in order to not interfere with the game presentation or progress. Yamada et al. will display these symbols in the case a match is not affirmed, even when the match determination is made for a plurality of times (Column 4, lines 33-54).

Furthermore, it would have been obvious to one skilled in the art at the time of invention to incorporate the sequence matching means and display prompting for key sequences of Yamada et al. into the player prompting of Aoshima et al. Both Aoshima et al. and Yamada et al. represent systems that are directed at aiding a user in understanding the control of an input device in a gaming system. By incorporating these two systems with an identical purpose, it would be possible to inform the player if his or her input matched the input provided by the



prompt. Furthermore, because Aoshima et al. allows for indirect prompting, experienced players would feel less intrusion by the prompting. Likewise, by using indirect prompting as disclosed by Aoshima et al. along with the key sequencing as taught by Yamada et al., one would be able to present the player with an indirect guidance of a key sequence to be performed. Yamada et al. teach that these key sequences are important to master in order to understand how to control the character in the game. By incorporating these sequence teachings into Aoshima et al., one would be able to indirectly prompt users on how to perform key sequences. One would be motivated to use this indirect prompting in this manner in order to inform players as to how to use the device without being intrusive and thus allowing advanced players to be able to ignore the prompting, or disable it all together, as disclosed by Aoshima et al.

By disclosing key sequences as well as whether or not the sequence is correct to players in an indirect manner, the combination would allow the player to become more skilled at a faster rate, as they would be visually informed of the incorrect, as well as correct, input to the game. This would further increase enjoyment among the players as they would take pleasure in a game much more if they were to improve at a rapid rate due to viable, informative, yet unobtrusive feedback in association with the indirect prompts of key operation. Likewise, these instructions are then presented in a manner in which advanced players could ignore or disable them; henceforth, providing enjoyment to all classes and levels of players.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**US Patent No. 6,425,822:** Device with prompting to aid inexperienced players in the operational functionality of the input device. The screen will prompt the user with which buttons to push when as well as displaying a character that moves with the prompting.

**US Patent No. 6,488,586:** Entertainment system that includes a program to aid the player in controlling the character. The player character is a displayed object that will react to the prompting.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3713

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:00AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Martin-Wallace can be reached on (703)-308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

*cmm*

cmm

April 7, 2003



**MICHAEL O'NEILL  
PRIMARY EXAMINER**